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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/896,231	06/29/2001	Arturo A. Rodriguez	A-7259	9416
5642	7590	05/17/2006	EXAMINER	
SCIENTIFIC-ATLANTA, INC. INTELLECTUAL PROPERTY DEPARTMENT 5030 SUGARLOAF PARKWAY LAWRENCEVILLE, GA 30044			LAYE, JADE O	
			ART UNIT	PAPER NUMBER
			2623	

DATE MAILED: 05/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Advisory Action Before the Filing of an Appeal Brief</b>	Application No. <b>09/896,231</b>	Applicant(s) <b>RODRIGUEZ ET AL.</b>
	Examiner <b>Jade O. Laye</b>	Art Unit <b>2623</b>

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 29 March 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1.  The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- The period for reply expires 3 months from the mailing date of the final rejection.
- The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### NOTICE OF APPEAL

2.  The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

#### AMENDMENTS

3.  The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because

- They raise new issues that would require further consideration and/or search (see NOTE below);
- They raise the issue of new matter (see NOTE below);
- They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4.  The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5.  Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.

6.  Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7.  For purposes of appeal, the proposed amendment(s): a)  will not be entered, or b)  will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: \_\_\_\_\_.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

#### AFFIDAVIT OR OTHER EVIDENCE

8.  The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9.  The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

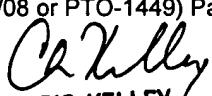
10.  The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

#### REQUEST FOR RECONSIDERATION/OTHER

11.  The request for reconsideration has been considered but does NOT place the application in condition for allowance because: refer to attached action.

12.  Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). \_\_\_\_\_.

13.  Other: P92

  
**CHRIS KELLEY**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 2600**  
Jade O Laye  
AU 2623

## **ADVISORY ACTION**

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### ***Response to Arguments***

I. Applicant's arguments filed 3/29/06 have been fully considered but they are not persuasive. Accordingly, the Examiner maintains the previous ground of rejection.

At the outset, the Examiner would like to note the objections of Claims 15-18 were withdrawn in the previous Final Office Action on Page 2. The Examiner did overlook and fail to delete the portions of the action that discuss the deleted claim language. This was a simple oversight. However, the limitation was addressed on page 8 of the action. Thus, the claims did receive a second examination on the merits and will remain finally rejected.

Applicant argues Haddad fails to teach the reallocation of excess on-demand bandwidth. (Pg. 5, Response). The Examiner disagrees. Instead of using the bandwidth during peak hours, the system of Haddad can reallocate that bandwidth to be used during off-peak hours, where there will be lower demand because of extra, or excess, bandwidth. Since the system of Haddad operates dynamically (i.e., user's can request video at anytime), the system is constantly allocating and reallocating bandwidth. Therefore, Haddad does in fact teach the reallocation of excess on-demand bandwidth.

Next, Applicant argues Rodriguez fails to disclose recordable content. (Pg. 4, Response). Applicant goes on to argue there is also no teaching of recording the downloading content. The Examiner agrees and disagrees, respectively.

Rodriguez does disclose the use of "recordable content." Throughout the reference, Rodriguez makes reference to video and related media. The Examiner interprets video as

encompassing “*recordable* content.” This logic if founded on the reasoning that, because video can be recorded---it is “recordable.” Accordingly, Rodriguez teaches all limitations of Claim 1.

The Examiner agrees Rodriguez does not appear to teach the recording of video data. However, this is not claimed in Claim 1. Claim 1 only calls for the use of “recordable content” or video, not that said video be recorded. Thus, again, Rodriguez teaches all limitations of Claim 1.

Next, although the Examiner provided a reference, Applicant traverses the finding that charging less for extended download times was notoriously well known. (Pg. 9, Response). Applicant goes on to state that the alleged teaching of an element in a patent reference does not in itself provide that elements are notoriously known. However, the Examiner must disagree based upon two observations: (1) Applicant provides no legal basis for this assertion and, (2) the current Office policy allows Official Notice to be based upon a single reference disclosing the argued limitation. Therefore, the Examiner considers the cited reference (i.e., *Aggarwal*) sufficient to establish the basis of the Official Notice.

Applicant goes on to state that, “to be the basis of a rejection, the element must be well known in combination with each and every element of the claim.” However, the Examiner doubts this is a correct interpretation of the law. In stark contrast, the Examiner interprets *ALCO* (as discussed by Applicant on page 10) as requiring there be some suggestion or motivation to make the combination, not that each and every limitation be well known in combination with all other limitations as argued by Applicant. As such, the Examiner asserts there is such a suggestion or motivation. As stated on Page 11 of the previous action, *Aggarwal* discloses a video system which charges less for extended download times, while *Haddad* discloses a similar

system that varies prices for different download times. Thus, you have a clear motivation/suggestion to combine: providing an incentive to request extended download times, thus freeing up more peak bandwidth. Accordingly, there is a clear motivation to combine *Aggarwal* with the cited references.

Regarding Claims 40, 45, 47, and 49, Applicant mirrors the previous argument. (Pg 11, Response). However, the Examiner disagrees based on the same reasoning. Accordingly, there was a clear motivation to combine *LaJoie*: to provide a system comprising a user interface to purchase media, thereby supplying a more user-friendly device. Thus, the combination of *LaJoie* with the cited references was proper.

Next, Applicant traverses the finding that the use of buffers is well known in the art of telecommunications. (Pg. 9, Response). Applicant goes on to state how the subject matter alleged to be well known is to complex for a reasonably skilled person to consider it to be well known to the point that no additional evidence is needed. The Examiner disagrees for the same reasons are previously discussed. However, since no reference was provided, the Examiner introduces *Hooper*, US Pat. No. 5,414,555, Abstract & Col. 2, Ln. 8-15 (cited previously). Accordingly, the use of buffers in video systems was well known at the time of Applicant's invention.

Next, Applicant traverses the finding that storing new releases in video servers was well known. (Pg. 10, Response). Applicant, again, goes on to state how the subject matter alleged to be well known is to complex for a reasonably skilled person to consider it to be well known to the point that no additional evidence is needed. In response, the Examiner cites *Bradely et al*, US Pat. No. 5,172,413 Column 7, Ln. 63-Col. 8, Ln. 11, which discloses the

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storing of new release movies. Accordingly, this limitation was well known at the time of Applicant's invention.

Regarding Claim 61, Applicant again traverses the Examiner's Official Notice even though a reference was provided. (Pg. 12, Response). However, the Examiner, again, disagrees and reasons the suggestion and/or motivation for combining *Pond* was clear: to provide a system which debits user's accounts for transactions, thereby supplying a more convenient and user friendly system. Thus, the combination of Pond with the cited references was proper.

Lastly, the Examiner would again like to direct Applicant's attention to the following references: WO 00/78031, Published in December 2000, also invented by Rodriguez and Jerding, and WO 00/78047, also published in December 2000 and also naming Rodriguez and Jerding as co-inventors. Upon a cursory review, each reference appears to disclose most, if not all, of what Applicant is claiming in the present action. However, at this stage of prosecution, the present rejection has not been overcome. **Also please note each reference is available under 102(a), therefore Applicant's 102(e) arguments, discussed in the previous action, would be unavailable. Moreover, 102(a) references do not fall under 35 U.S.C. 103(c)'s prohibition regarding commonly owned or assigned inventions, thus, each could be applied under 103(a).**

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jade O. Laye whose telephone number is (571) 272-7303. The examiner can normally be reached on Mon. 7:30am-4, Tues. 7:30-2, W-Fri. 7:30-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Kelley can be reached on (571) 272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Examiner: Jade O. Laye

Initials:

May 6, 2006.



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